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| KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005 | | | PHUONG, DAI | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/612,970 | Applicant(s) HOLMES, DAVID W. | |
| | Examiner Dai A. Phuong | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/22/2006 has been entered.

Response to Amendment

2. Applicant's arguments, filed 03/22/2006, with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Claims 7-8 and 16 have been canceled and claim 21 has been added. Claims 1-6, 9-15 and 17-21 are currently pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8-19, 21-31 and 33-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al. (Pub. No: 20050113074) in view of Lunsford et al. (Pub. No: 2002/0065041).

Regarding claim 1, Holt et al. disclose a method comprising: generating a dialing request at a remote control device based on an operation of a dedicated control of the remote control

device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service including at least one of a voice controlled and a messaging service (fig. 1B, See abstract and [0060] to [0061]). However, Lunsford et al. do not disclose transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal instructing the mobile communication device to access the network-based communication services.

In the same field of endeavor, Lunsford et al. disclose transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal instructing the mobile communication device to access the network-based communication services ([0057] to [0059] and [0064] to [0067]). It is inherent that the PID 12 instructs the telephone 14 *accesses to the network* in order to make a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal instructing the mobile communication device to access the network-based communication services, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

Regarding claims 2, 24, 37, 45, 53, 55 and 57, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1, 23, 36, 44, 52, 54 and 56 respectively. Further, Lunsford et al. disclose the method wherein the dialing request is initiated by a user manipulation of an access button that is dedicated to the network-based communication services ([0057] to [0059] and [0064] to [0067]).

Regarding claims 3, 25, 39, 47 and 58, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1, 23, 36, 44 and 56 respectively. Further, Holt et al. disclose the method wherein the voice-controlled service is a voice information service, the voice information service enabling a user to use information retrieval at a network server ([0060] to [0061]).

Regarding claims 4, 26, 40, 48 and 59, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 1, 23, 36, 44 and 56 respectively. Further, Holt et al. disclose the method wherein the voice-controlled service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server ([0060] to [0061]).

Regarding claims 5, 27, 35, 41, 49, 60 and 61, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1, 23, 33, 36, 44 and 56 respectively. . Further, Holt et al. disclose the method wherein the network-based communication service is an automated communication service that does not require voice commands ([0060] to [0061]).

Regarding claims 8 and 42, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1 and 36 respectively. Further, Holt et al. disclose the method wherein the dialing signal includes a telephone number associated with the voice-control service, the

method further including retrieving the telephone number from a memory of the remote control device ([0060] to [0061]).

Regarding claim 9, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 8. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory before generating the dialing request ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 10, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a user of the mobile communication device ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 11, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Holt et al. disclose the method further including storing the telephone number to the memory based on input from a provider of the network-based communication services ([0060] to [0061]).

Regarding claim 12, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the telephone number to the memory is initiated by the provider of the network-based communication services ([0060] to [0061]).

Regarding claim 13, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the

telephone number to the memory is initiated by a user of the remote control device ([0060] to [0061]).

Regarding claim 14, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a manufacturer of the remote control device ([0060] to [0061]).

Regarding claim 15, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 9. Further, Holt et al. disclose the method further including verifying authorization to write to the memory before storing the telephone number ([0060] to [0061]).

Regarding claims 16 and 28, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1 and 23 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs over a wireless connection with the mobile communication device ([0029] to [0036] and [0045] to [0052]).

Regarding claims 17 and 29, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 16 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is a radio frequency (RF) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 18, 30 and 43, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 17, 29 and 36 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs in accordance with a Bluetooth standard ([0029] to [0036] and [0045] to [0052]).

Regarding claims 19 and 31, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 17 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is an infrared (IR) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 21 and 50, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method wherein the mobile communication device is a personal digital assistant (PDA) configured for wireless communication ([0026] to [0030]).

Regarding claims 22 and 51, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method wherein the mobile communication device is a wireless phone ([0026] to [0030]).

Regarding claim 23, Holt et al. disclose a method of remotely accessing a network-based communication service comprising: network-based communication services including at least one of the voice-control and a messaging service (fig. 1B, see abstract and [0060] to [0061]). However, Holt et al. do not disclose receiving a dialing signal from the remote control device at a mobile communication device, the dialing signal being based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication services; and accessing the network-based communication service in response to the dialing signal.

In the same field of endeavor, Lunsford et al. disclose receiving a dialing signal from the remote control device at a mobile communication device (fig. 1, [0026], [0057] to [0059] and

[0064] to [0067]), the dialing signal being based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication services (fig. 1, [0026], [0057] to [0059] and [0064] to [0067]); and accessing the network-based communication service in response to the dialing signal (fig. 1, [0057] to [0059] and [0064] to [0067]). It is inherent that the PID 12 instructs the telephone 14 *accesses to the network* in order to make a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including receiving a dialing signal from the remote control device at a mobile communication device, the dialing signal being based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication services; and accessing the network-based communication service in response to the dialing signal, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

Regarding claim 33, Holt et al. disclose a method of accessing a network-based communication service comprising: verifying authorization to write to a memory of a remote control device (fig. 2A, [0060] to [0061]); storing a telephone number to the memory of the remote control device, the telephone number being associated with the network-based

communication service (fig. 2A, [0060] to [0061]); generating a dialing request based on user input to the remote control device (fig. 2A, [0060] to [0061]), the dialing request being initiated by a user manipulation of an access button that is dedicated automatically forming a connection to network-based communication services including at least one of a voice-controlled and a message service (fig. 2A, [0060] to [0061]). However, Holt et al. do not disclose transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal including the telephone number and instructing the mobile communication device to access the network-based communication service; receiving the dialing signal at the mobile communication device; and using the telephone number to remotely access the network-based communication services.

In the same field of endeavor, Lunsford et al. disclose transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal including the telephone number and instructing the mobile communication device to access the network-based communication service ([0026], [0057] to [0059] and [0064] to [0067]); receiving the dialing signal at the mobile communication device ([0026], [0057] to [0059] and [0064] to [0067]); and using the telephone number to remotely access the network-based communication service ([0057] to [0059] and [0064] to [0067]). It is inherent that the PID 12 instructs the telephone 14 *accesses to the network* in order to make a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including

transmitting a dialing signal from the remote control device toward a mobile communication device based on the dialing request, the dialing signal including the telephone number and instructing the mobile communication device to access the network-based communication service; receiving the dialing signal at the mobile communication device; and using the telephone number to remotely access the network-based communication services, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

Regarding claim 36, Holt et al. disclose a remote control device comprising: a user interface including an access button that is dedicated automatically forming a connection to network-based communication services including at least one of a voice-controlled and a message service (fig. 2A, [0060] to [0061]), user manipulation of the button to initiate a dialing request (fig. 2A, [0060] to [0061]). However, Holt et al. do not disclose a remote communication module coupled to the user interface, the remote communication module to transmit a dialing signal toward a mobile communication device based on the dialing request from the user interface, the dialing signal to instruct the mobile communication device to access the network-based communication service.

In the same field of endeavor, Lunsford et al. a remote communication module coupled to the user interface, the remote communication module to transmit a dialing signal toward a mobile communication device based on the dialing request from the user interface, the dialing signal to instruct the mobile communication device to access the network-based communication service ([0026] to [0035], [0045] to [0052], [0057] to [0059] and [0064] to [0067]). It is inherent

that the PID 12 instructs the telephone 14 *accesses to the network* in order to a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including a remote communication module coupled to the user interface, the remote communication module to transmit a dialing signal toward a mobile communication device based on the dialing request from the user interface, the dialing signal to instruct the mobile communication device to access the network-based communication service, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

Regarding claim 38, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 36. Further, Holt et al. disclose the remote control device wherein the user interface has no buttons other than the access button ([0060] to [0061]).

Regarding claim 44, Holt et al. disclose a network-based communication service including at least one of a voice controlled and a messaging service ([0060] and [0061]). However, Holt et al. do disclose a mobile communication device comprising: a phone communication module, the phone communication module to receive, from the remote control device, a dialing signal that is based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a

connection with network-based communication service; and a wireless transceiver coupled to the phone communication module, the wireless transceiver to access the network-based communication service in response to the dialing signal.

In the same field of endeavor, Lunsford et al. disclose a mobile communication device comprising: a phone communication module, the phone communication module to receive, from the remote control device, a dialing signal that is based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service ([0026] to [0036] and [0056] to [0062]); and a wireless transceiver coupled to the phone communication module, the wireless transceiver to access the network-based communication service in response to the dialing signal ([0026] to [0036] and [0056] to [0062]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including a phone communication module, the phone communication module to receive, from the remote control device, a dialing signal that is based on an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service; and a wireless transceiver coupled to the phone communication module, the wireless transceiver to access the network-based communication service in response to the dialing signal, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

Regarding claim 46, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claim 44. Further, Holt et al. disclose the mobile communication device further including a memory to store a telephone number associated with the network-based communication service, the wireless transceiver to use the telephone number to access the network-based communication services in response to the dialing signal ([0060] to [0061])

Regarding claim 52, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 54, this claim is rejected for the same reason as set forth in claim 23.

Regarding claim 56, Holt et al. disclose a method of providing a network-based communication service comprising: including at least one of a voice controlled and a messaging service ([0060] to [0061]). However, Holt et al. do not disclose receiving a call from a mobile communication device, the call being initiated by an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service, the remote control device generating the dialing request to the mobile communication device; and generating a network-based communication service during the call.

In the same field of endeavor, Lunsford et al. disclose receiving a call from a mobile communication device, the call being initiated by an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service, the remote control device generating the dialing request to the mobile communication device ([0057] to [0059] and [0064] to [0067]). It is inherent that the PID 12 instructs the telephone 14 *accesses to the*

network in order to a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected); and generating a network-based communication service during the call ([0057] to [0059] and [0064] to [0067]). It is inherent that the PID 12 instructs the telephone 14 *accesses to the network* in order to make a connection between the telephone 14 with the predetermined telephone number that the user of PID 12 has been selected).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Holt et al. by specifically including receiving a call from a mobile communication device, the call being initiated by an operation of a dedicated control of the remote control device, the dedicated control dedicated to generating the dialing request to automatically form a connection with network-based communication service, the remote control device generating the dialing request to the mobile communication device; and generating a network-based communication service during the call, as taught by Lunsford et al., the motivation being in order to provide a solution which enables a user's device to seamlessly interact with the user's telephone to dial members and establish phone calls without requiring the user to access controls of the telephone.

5. Claims 6-7 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al. (Pub. No: 20050113074) in view of Lunsford et al. (Pub. No: 2002/0065041) and further in view of Cheung (Pub. No: 2004/0024647).

Regarding claims 6 and 62, the combination of Holt et al. and Lunsford et al. disclose all the limitation in claims 5 and 56 respectively. However, the combination of Holt et al. and

Lunsford et al. do not disclose the method wherein accessing the automated communication service results in an automatic playing of a prerecorded message.

In the same field of endeavor, Cheung discloses the method wherein accessing the automated communication service results in an automatic playing of a prerecorded message ([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of the combination of Holt et al. and Lunsford et al. by specifically including accessing the automated communication service results in an automatic playing of a prerecorded message, as taught by Cheung, the motivation being in order to notify a customer of the occurrence of an event.

Regarding claims 7 and 63, the combination of Holt et al. and Lunsford et al. disclose all the limitation in claims 5 and 56 respectively. However, the combination of Holt et al. and Lunsford et al. do not disclose the method wherein accessing the automated communication service results in an automatic registering of a vote.

In the same field of endeavor, Cheung discloses the method wherein accessing the automated communication service results in an automatic registering of a vote ([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of the combination of Holt et al. and Lunsford et al. by specifically including accessing the automated communication service results in an automatic registering of a vote, as taught by Cheung, the motivation being in order to notify a customer of the occurrence of an event.

6. Claims 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al. (Pub. No: 20050113074) in view of Lunsford et al. (Pub. No: 2002/0065041) in view of Kumar et al. (Pub. No: 2003/0081758).

Regarding claims 20 and 32, the combination of Holt et al. and Lunsford et al. disclose all the limitations in claims 1 and 29 respectively. However, the combination of Holt et al. and Lunsford et al. do not disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device.

In the same field of endeavor, Kumar et al. disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device ([0021] to [0022]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of the combination of Holt et al. and Lunsford et al. by specifically including the transmitting of the dialing signal occurs over a wired connection with the mobile communication device, as taught by Kumar et al., the motivation being in order to enable personal digital assistant to quickly and accurately transmit stored telephone numbers directly to other communication device containing a dialing device.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen M Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7503.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong

AU: 2617

Date: 05-11-2006


ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER